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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRONZ F. BATOT, RANDY S. JOHNSON,
TEDRICK N. NORTHWAY, PAUL D. PETERSON, and
HOWARD N. SMALLOWITZ

Appeal 2016-001015
Application 11/523,200
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
NINA L. MEDLOCK, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1–16. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants' invention is directed to disaster recovery management services that support physical disaster recovery operations. Spec. 1.

Claim 1 is illustrative:

1. A method for prioritizing a multiplicity of management services which manage physical disaster recovery operations, the method comprising the steps of:

a computer determining from a database a criticality of each of the management services;

the computer determining from a database an urgency of recovery of each of the management services;

the computer determining from a database respective numbers of the management services which support each of the management services;

the computer determining and electronically reporting a priority to perform each of the management services based on (a) the criticality of said each management service, (b) the urgency of said each management service and (c) the number of the management services which support said each management service;

the computer selecting one or more of the management services whose determined priority exceeds a predetermined threshold; and

performing the selected one or more management services, wherein implementing the physical disaster recovery operations in response to a disaster comprises said performing the selected one or more management services, and wherein the physical disaster recovery operations comprise restoring services that existed prior to the disaster, providing services for emergency and interim relief in response to the disaster, or a combination thereof.

Appellants appeal the following rejection:

Claims 1–16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

PRINCIPLES OF LAW

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The

Supreme Court, however, has long interpreted § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (internal quotations and citation omitted).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 76–77 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk”); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter”); *Parker v. Flook*, 437 U.S. 584, 594–95 (1978) (“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals”).

The patent-ineligible end of the spectrum includes fundamental economic practices (*Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611); mathematical formulas (*Flook*, 437 U.S. at 594–95); and basic tools of

scientific and technological work (*Benson*, 409 U.S. at 69). On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber (*Diamond*, 450 U.S. at 184 n.7 (“tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores”)), and a process for manufacturing flour (*Gottschalk*, 409 U.S. at 69).

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an “inventive concept”—an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* (internal quotations and citation omitted).

ANALYSIS

The Examiner held that the claims were directed to the abstract idea of a method of organizing human activities, managing a physical disaster recovery operation. Final Act. 6. The Examiner further held that the instant Specification describes the management services as, for example, search and rescue, remote evacuation, and morgue and that a person of ordinary skill would have recognized these activities as fundamentally human in nature within the scope of common commercial practices of each of the management services. Ans. 5.

In regard to the second step of *Alice*, the Examiner found that elements in addition to the abstract idea amount to no more than a recitation of a generic computer structure that serves to perform generic computer

functions that are well-understood, routine and conventional. Final Act. 6. The Examiner also found that the database is simply a look-up table in which the users enter the relevant information based on the user's experience, research, and logic. Ans. 5.

The Examiner held that the recitation of performing the selected one or more management services is a recitation of insignificant extra-solution activity.

We agree with the Examiner that the claim 1 is directed to an abstract idea for the reasons given by the Examiner. In addition, we note that claim 1 is directed to data gathering, storing and processing and that claims involving data collection, analysis, and display have been found to be directed to an abstract idea. *See Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent-ineligible concept”); *see also In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016).

Claim 1, unlike the claims found non-abstract in prior cases, uses generic computer technology to perform data collection, analysis, and display and does not recite an improvement to a particular computer technology. *See, e.g., McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (finding claims not abstract because they “focused on a specific asserted improvement in computer animation”). As such, we agree that the other recitations in the claims do not amount to significantly more than the abstract idea. We also agree with

the Examiner that the recitation of performing the selected one or more management services reflects extra-solution activity and no more than well-understood, routine, and conventional steps previously known to the industry. *See Mayo*, 566 U.S. at 79 (holding that purely conventional or obvious pre-solution or post-solution activity is normally not sufficient to transform an unpatentable law of nature into a patent-eligible application of such a law); *Alice*, 134 S. Ct. at 2359. The step of performing well-known physical disaster recovery operations is insufficient to transform the claim into a patent-eligible application of the abstract idea. *See Alice*, 134 S. Ct. at 2358.

We are not persuaded of error on the part of the Examiner by Appellants' argument that the claims are not directed to an abstract idea because the claims are not directed to the kind of methods of organizing of human activity found to be abstract by the courts and that the claims are not directed to a mathematical formula. In our view, the instant claims, which are directed to managing a physical disaster recovery, are similar to claims found to be directed to organizing human activity. *See, e.g., Planet Bingo, LLC v. VKGS, LLC*, 961 F.Supp.2d 840, 851 (W.D. Mich. 2013).

We are likewise not persuaded that the claims are not directed to an abstract idea because they are not directed to a mathematical formula. We agree with the Examiner that the claims are directed, at least in part, to determining priority to perform management services in accordance with the mathematical formula found on page 9 of the Specification.

In any case, as we stated above, our reviewing court has repeatedly held that claims directed to data storage and analysis such as the instant claims are directed to abstract ideas. *See, e.g., Internet Patents Corp. v.*

Active Network, Inc., 790 F.3d 1343, 1349 (Fed. Cir. 2015); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 701 (2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011).

We are not persuaded of error on the part of the Examiner by Appellants' argument that the claims improve another technical field and effectuate a physical transformation. The Appellants argue that the claims improve the technical field of implementing physical disaster recovery operations in response to a disaster. However, the improvements alleged by the Appellants are not improvements to a technical field such as an improvement to computer capabilities, but instead relate to an alleged improvement in implementing disaster relief for which a computer is used only as a tool in its ordinary capacity.

We are not persuaded of error on the part of the Examiner by Appellants' argument that the claimed limitation of "determining from a database respective members of the management services which support each of the management services" is not well-understood, routine and conventional in the field of managing a physical disaster recovery operation and, thus, is significantly more than the alleged abstract idea. Appellants argue that novelty considerations should be invoked. Although the second step in the *Alice/Mayo* framework is termed a search for an "inventive concept," the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for "an element or combination of elements that is

sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”” *Alice*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90.

Appellants’ argument regarding preemption is likewise not persuasive. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs.*, 788 F.3d at 1362–63 (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract”). And, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

In view of the foregoing, we will sustain the Examiner’s rejection as it is directed to claim 1.

We are not persuaded of error on the part of the Examiner by Appellants’ arguments directed to the remaining claims. We agree with the Examiner’s response to the arguments regarding these claims found on pages 13–18 of the Answer and adopt the same as our own.

DECISION

We affirm the § 101 rejection of claims 1–16 for the reasons of record.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1).

AFFIRMED